

Remarks/Arguments:

With this amendment, the applicants amend claims 28 and 29 at the direction of the Examiner's suggestion set forth at page 2, paragraph 2 of the Office Action. Claims 1-18, 23, 24, 27-34 are pending.

I. Examiner Interviews

The applicants appreciate the opportunity given their counsel, Christopher R. Lewis and Christian M. Bauer, to discuss the subject matter of the claimed invention in a telephone interview with Examiner Oropeza on October 27, 2004 (see Interview Summary Record, mailed 11/04/04) and November 9, 2004 (See below).

A. Interview Summary mailed November 4, 2004

The applicants would like to make of record the following regarding the Interview Summary. The Interview Summary states: "The Examiner confirmed that Barak was found to disclose claims 31-34." The applicants respectfully disagree. There can be no such confirmation that Barak et al. discloses the subject matter of claims 31-34 because no such rejection was made in the previous Office Action. The previous Office Action of October 19, 2004 sets forth a rejection under 35 U.S.C. § 103(a) that claims 31-34 are unpatentable over Gardner et al. in view of Barak et al., not Barak et al. alone.

The applicants appreciate the Examiner's confirmation that the Mori et al. reference is not a valid prior art reference.

The applicants do, however, take issue with the statement: "the Examiner noted this limitation [the pressure generator being secured to the cuff] was not believed to be a novel feature as mounting and measuring device to a cuff/band appears to be common in the art... ." The examiner noted two additional references as disclosing such a limitation (U.S. 5,906,582 and U.S. 5,778,879).

The applicants cannot respond to this statement without an explanation by the Examiner detailing how these references, either alone or in combination, render the claims unpatentable.

B. Telephone Interview of November 9, 2004

The applicants make the substance of the interviews of record, in compliance with 37 C.F.R. §§ 1.2 & 1.133(b) and M.P.E.P. § 713.04, as follows. The interview began by Mr. Bauer providing a review of the inventive subject matter. Next, Mr. Bauer summarized the prosecution history, including mentioning that claims 20 and 23-26 were indicated as allowable in the Office Action of April 19, 2004. The applicants had relied on this statement in preparing a response to that Office Action. Then, Mr. Bauer discussed the current Office Action. No

resolution of the pending claims was reached. The applicants agreed to substantively respond to the Office Action.

II. The Office Action

Paragraph 3, page 3 rejects claims 1 and 31-34 under 35 U.S.C. § 103(a) as unpatentable over Gardner et al. in view of Barak et al. Claims 1 and 31-34 were previously amended to incorporated the allowed subject matter of claims 20 and 23-26 as indicated by the Office Action of April 19, 2004. With the current Office Action, no new reference or additional reasons were given for the rejection of the previously allowed subject matter contained in claims 1 and 31-34.

The MPEP § 706.04 states that a claim noted as allowable shall thereafter be rejected only after the proposed rejection has been submitted to the primary examiner for consideration of all the facts and approval of the proposed action. The MPEP emphasizes that great care should be exercised in authorizing such a rejection. See *Ex parte Grier*, 1923 C.D. 27, 309 O.G. 223 (Comm'r Pat. 1923); *Ex parte Hay*, 1909 C.D. 18, 139 O.G. 197 (Comm'r Pat. 1909). The applicants respectfully request acceptance of the previously allowed claims, or request the Examiner to provide reasons why the Examiner has changed her position.

The rejections maintained in paragraphs 4-7 of the Office Action cite Mori et al. to support the rejections. As acknowledged by the Examiner, Mori et al. is not a proper prior art. With the removal of Mori et al., the rejections are the same as those set forth in the April 19, 2004 Office Action. By the incorporation of the allowable subject matter of claims 20 and 23-26, applicants submit that these rejections have also been overcome.

III. Conclusion

The applicants submit that the pending rejections have been overcome and respectfully request early notification of the allowance of the application. If the Examiner issues a rejection, the applicants presume such a rejection would be non-final, despite the amendment to the claims, because the amendment to the claims was made at the Examiner's direction (see page 2, paragraph 2 of the Office Action). This amendment is not being made in response to the prior art rejection.

Respectfully submitted,



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